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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/645,368

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James Ray Rogers

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7590

11/01/2006

Kit M Stetina, Esq.
STETINA BRUNDA GARRED & BRUCKER
Suite 250
75 Enterprise
Aliso Viejo, CA 92656

EXAMINER

RODRIGUEZ, RUTH C

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,368

Applicant(s)

ROGERS, JAMES RAY

Examiner

Ruth C. Rodriguez

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,7,8 and 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6 and 9-14 is/are rejected.
- 7) ☐ Claim(s) 15 and 16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9 October 2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species:

Species I - Figures 1-6 - Claims 1, 2 and 5-9

Species II - Figures 7-11 - Claims 1, 2, 5, 6 and 9-16

Species III - Figures 12-17 - Claims 1-6, 8, 9 and 20-24

Species IV - Figures 18-21 - Claims 1-6, 8, 10 and 17-19

The species are independent or distinct because species I is a single piece accessory device that has an opening frictionally engaging a button, species II comprises a base, a display object and a foldable bar connecting the base and the display object where the base has an elongated slot to engage the button, species III comprises two sections with a notch provided on a lower portion of each section and when mated the button is retained with the accessory device through the notches and species IV has a base with a plurality of finger to engage the button and the display object is placed over the base.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, 5 and 6 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

2. During a telephone conversation with Kit M. Stetina on 19 October 2006 a provisional election was made with traverse to prosecute the invention of Species I, claims 1, 2, 5, 6 and 9-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 4, 7, 8 and 17-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

3. The information disclosure statement filed 09 October 2006 has been considered for this Office Action.

Claim Objections

4. Claims 9-11 and 14 are objected to because of the following informalities:

- Claim 9 recites the limitation "the display" in the first line. There is insufficient antecedent basis for this limitation in the claim.
- Claim 10 recites the limitation "the base unit" in the fourth line. There is insufficient antecedent basis for this limitation in the claim.
- Claim 11 recites the limitation "the attaching unit" in the sixth line. There is insufficient antecedent basis for this limitation in the claim.
- Claim 14 recites the limitation "the display object" in the first line and "the snap-on structure" in the second line. There is insufficient antecedent basis for this limitation in the claim.

Correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5, 9, 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Gould (US 5,621,951).

An accessory device comprises a base (10) and a display object (18). The base has an opening (12) that extends at least partially through the base. The opening is sized so as to extend axially over and frictionally engage the button (Figs. 6-8). The display object is attached to the base (Figs. 1-8).

The device can be formed via injection molding processes (Figs. 1-8) since the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

The base and the display object are integrally formed (Figs. 1-8).

An accessory device comprises an attaching unit (10) and a display (18) to be snapped to the attaching unit (Figs. 1-8).

The display comprises a bottom rim mating the snap-on unit (Figs. 1-8).

7. Claims 1, 5, 6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Herman (US 5,542,157).

An accessory device (1206) comprises a base (inner surface of 1206) and a display object (1206). The base has an opening that extends at least partially through the base (Figs. 49-52). The opening is sized so as to extend axially over and frictionally engage the button (Figs. 49-52). The display object is attached to the base (Figs. 49-52).

The device can be formed via injection molding processes (Figs. 49-52) since the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

The display object is a figurine (Figs. 49-52).

The base and the display object are integrally formed (Figs. 49-52).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gould in view of Herman (US 5,542,157).

Gould teaches an accessory device having all the features being mentioned above for the rejection of claim 1. The attachment unit comprises a base unit (10), a snap-on unit (18) and a foldable bar (16). The base unit has a bottom plate (10) slidable underneath the button (Figs. 6-8) and a lower latching structure (24) protruding from the bottom plate (Figs. 1-8). The snap-on unit has an upper latching structure (28) at an interior surface thereof for engaging with the lower latching structure (Figs. 1-8). The foldable bar connects the base unit and the attaching unit as a hinge (Figs. 1-8). Gould fails to disclose that the snap on-unit has a snap-on structure at an exterior surface thereof for attaching the display thereto. However, Herman teaches an accessory device having all the features mentioned above. The accessory object allows having one or more interchangeable ornamentations being placed over a button (C. 15, L. 49-67 and C. 16, L. 1-15). Therefore, it would have been obvious to one

having ordinary skill in the art at the time the invention was made to have a snap-on structure at an exterior surface thereof for attaching the display as taught by Herman in the accessory device disclosed by Gould. Doing so, allows the use of one or more interchangeable ornamentalations being placed over a button.

Gould discloses that the base unit, the snap-on unit and the foldable bar are integrally formed (Figs. 1-8).

The periphery of the base unit disclosed by Gould is smaller than the periphery of the snap-on unit (Figs. 1-8).

Allowable Subject Matter

10. Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Goodwin (US 581,111), Armbruster (US 2,751,654), Corbi (US 2,834,080), Darvie (US 3,343,230), Hardin (US 4,918,791), Szedzinski (US 5,060,356), Jerjian (US 5,161,285), Fang (US 5,394,719), Stanesic et al. (US 6,381,806 B1) and Bishop (US

6,857,167 B2) are cited to show state of the art with respect to accessory devices used to cover a button.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase the patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as PTO's mailroom processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP § 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee that the applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

I hereby certify that this correspondence is being facsimile transmitted to
the Patent and Trademark Office (Fax No. (571) 273-8300) on (Date).

(Signature)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

Ruth C. Rodriguez
Patent Examiner
Art Unit 3677

rcr
October 30, 2006



ROBERT J. SANDY
PRIMARY EXAMINER